

REMARKS

The Office Action mailed on June 7, 2004, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-20 were pending in the present application. By this paper, Applicants do not cancel or add any claims. Therefore, claims 1-20 remain pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, Claims 1-2, 4-5, 7-15 and 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adriaensen (PCT/EP98/02980) in view of Bailey (GB 2153256), while claim 3 is rejected in further view of Daisel (JP 52126465A) and claim 6 is rejected in further view of Zeng (USP 5,807,430). Further, claim 16 stands rejected under the same statute in view of Adriaensen and Bailey when combined with Carey II (USP 5,489,490).

In response, Applicants respectfully traverse the rejection as to the claims above, and submit that these claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

Lack of Suggestion or Motivation to Modify or Combine the References

Claim 1, the only independent claim of the invention, stands rejected based on a combination of Applicants' own prior efforts in canvas reinforcement, **when combined with a reference related to cleaning teeth**. Applicants respectfully submit that even if someone of ordinary skill in canvas reinforcement decided to attempt to improve upon the teachings of Adriaensen, there is no evidence that such an artisan in 1999/2000 would look to techniques (in Bailey) involved in the construction of "*toothsticks*."

Applicants submit that the art of the Bailey reference is too far removed from Adriaensen to formulate an obviousness rejection under 35 U.S.C. §103(a). "[C]ommon sense" must be applied in deciding in which fields a person of ordinary skill would reasonably be expected to look. *Oetiker*, 24 U.S.P.Q.2d at 1446. In *Oetiker*, the Court found that "[i]t has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments." *Id.* In a similar fashion, a person of ordinary skill in the canvas arts **would not reasonably look to the teeth cleaning field** to improve a process or device.

Applicants also submit that the ordinary artisan would not have been motivated to look in the fishing line arts to find Daisel for similar reasons.

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As the Office Action correctly notes, Applicants previously identified (in the cited PCT application) that wires do not adhere well to a thermoplastic matrix material. Thus, Applicants previously directed their efforts towards utilizing cords, which, as they noted in the PCT application, have a higher adherence to thermoplastic matrix materials. That is, the primary reference teaches a suitable configuration for metal members that does **not** require an additional feature such as a primer that enhances adhesion of a thermoplastic matrix material to the metal. Thus, the cited PCT reference teaches away from the present invention because it identifies a problem and directs the skilled artisan to the use of cords to alleviate the problem.

Applicants again respectfully submit that one of ordinary skill in the art, relying on the cited PCT application, would not look to modify the PCT application, but would simply follow the teachings of the PCT application and utilize metal cords. **Such a modification to the teachings of the PCT application as proffered in the Office Action would only be undertaken by an innovator**; a person who, when faced with a problem, ignores the solution to a problem placed directly in front of him or her (i.e., the use of cords) and instead seeks an alternative solution previously untested.

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In the present case, Applicants have discovered, based on their continuing efforts to advance the field, that without the application of a primer layer to the metal members, the thermoplastic material disposed around the metal members flows away during welding of the strip to the canvas, sometimes resulting in a metal member that is no longer surrounded by the thermoplastic material after welding; increasing the susceptibility of the metal to corrosion. (See specification, page 3, first paragraph.) This problem is simply not identified in the prior art. Moreover, the invention according to any of the claims provides increased resistance against sharp shear forces (such as accidental clipping by a scissor device). Bailey does not disclose or suggest that either of these advantages are obtained by implementation of a primer coat. Thus, the skilled artisan would simply not have been motivated to look towards Bailey to improve the teachings of the cited PCT application. It simply would not have been obvious to combine Bailey with the teachings of the PCT application to arrive at the present invention. Such combination is made by the innovator and not by the ordinary artisan.

Claim 13

Claim 13 recites that the “metal member is a steel wire with a carbon content of **at least 0.40%.**” (Emphasis added.) Adriaensen teaches that suitable “metal materials include steel, copper or a low carbon steel wire with a carbon content **below .4%** (Page 5, 6-15).” (Office Action, page 3, lines 1-2, emphasis added.) Thus, Adriaensen teaches away from claim 13, even assuming *arguendo* that this feature is a result effective variable, and thus

discourages the skilled artisan from seeking an optimum value of the carbon content above .4%. Such a claim is not obvious in view of the cited references.

Claim 16

Claim 16 stands rejected based on the combination of the above cited references against claim 1, and Carey II (USP 5,489,490), which is relied on in the Office Action to teach a metal member coated with a zinc layer or with a zinc alloy layer.

The Office Action appears to rely on the alleged ease by which the references can be combined, contrary to the procedures stipulated in the MPEP. The MPEP specifically states that the “mere fact that references can be combined or modified does **not** render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (MPEP § 2143.01, subsection 3, first sentence, citations omitted.)

Also, the Office Action appears to suggest that there is a need to make fabric canvass reinforcements which are highly resistant to corrosion by coating a metal layer with zinc or a zinc alloy. However, there is nothing in any of the cited references that teaches or suggests such a need. Therefore, claim 16 is not obvious for yet another reason.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained above), the cited references still do not meet the third requirement vis-à-vis at least claim 12, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Claim 12 recites that the “metal member is a wire with a rounded I-profile.” The examiner recognizes that none of the cited references teach or suggest this element. It appears that the Office Action relies on common knowledge in the art, as is discussed and permitted in MPEP § 2144.03, to satisfy the third requirement of MPEP § 2143 vis-à-vis

claim 12. However, Applicants note that § 2144.03 allows an applicant “to traverse such an assertion,” and that when an applicant does so, “the examiner should cite a reference in support of his or her position.” (MPEP § 2144.03, second paragraph.) Applicants hereby traverse the assertion that it would have been common knowledge in the art to utilize the claimed configuration. **Applicants thus request, relying on § 2144.03 that the PTO cite a reference and exactly identify where such a reference teaches the missing elements of claim 12, else allow the claim.**

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In sum, even if the first requirement of MPEP § 2143 is satisfied (which it is not), the third requirement of MPEP § 2143 is not satisfied in the Office Action, at least in regard to claim 12, since the cited references, alone or in combination, do not teach or suggest each and every element of these claims.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

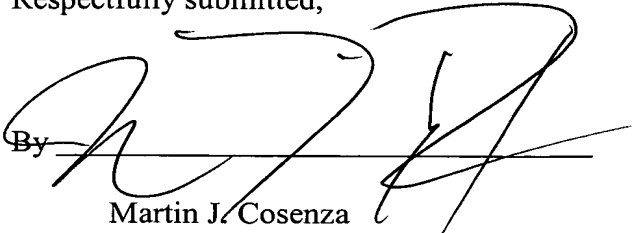
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Salvatore is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date Sep 03, 2004

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